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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|---|-------------|-----------------------|--------------------------|------------------|
| 10/666,703  | 09/19/2003  | James M. Mathewson II | RSW920030195US1          | 1989             |
| 7590<br>A. Bruce Clay<br>IBM Corporation<br>T81/503<br>PO Box 12195<br>Research Triangle Park, NC 27709 |             |                       | EXAMINER<br>BLOUNT, ERIC |                  |
|   |             |                       | ART UNIT<br>2636         | PAPER NUMBER     |
| DATE MAILED: 10/18/2005   |             |                       |                          |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/666,703

Applicant(s)

MATHEWSON ET AL.

Examiner

Eric M. Blount

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 10, 11, 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 3, 4, 12, 13, 21, 22, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 3, 5-9, 14-18, 21 and 23-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The Office acknowledges the changes made to the specification and claims by the applicant. All previous objections and 35 U.S.C. 112 2<sup>nd</sup> rejections have been withdrawn.

### *Claim Objections*

2. **Claims 3 and 12** are objected to because of the following informalities: Each of the claims recites the limitation "affixed to each or one or more". Appropriate correction is required.

3. **Claim 21** is objected to because of the following informalities: Each of the claims recites the limitation "affixed to each or one or more" in line 6. Appropriate correction is required.

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 3, 4, 12, 13, 21, 22, 26, and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 7, 16, 17, 26, 27, 29, and 30, respectively of copending Application No. 10/666,700. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims sets forth the limitations of obtaining information for identifying objects from a receipt, searching RFID tags affixed to monitored items for identifying information, and concluding whether objects were paid for or not. Though the co-pending application teaches scanning identifying information to make a determination as to whether or not an item had been purchased, it would have been obvious to one of ordinary skill in the art that reading a unique correlator value, as claimed in the instant application, would be an analogous operation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Allowable Subject Matter***

6. **Claims 5-9, 14-18, and 23-25** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. **Claims 1, 2, 10, 11, 19, and 20** are allowed. The following is an examiner's statement of reasons for allowance: The prior art of record fails to sufficiently describe or suggest a theft detection apparatus employing RFID technology wherein a unique

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correlator value is created for a current transaction as a function of at least one value and the unique correlator value is stored on each item which includes an RFID tag and a receipt for the current transaction. These along with further limitations, render the claims allowable over prior art.

### ***Conclusion***

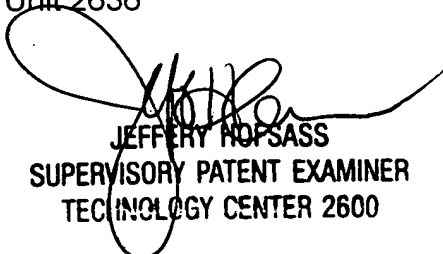
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M. Blount whose telephone number is (571) 272-2973. The examiner can normally be reached on 8:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on (571) 272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Eric M. Blount  
Examiner  
Art Unit 2636

  
JEFFERY HOPSASS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600